

U. S. Patent Application No. 09/858,163
Amendment Dated June 10, 2005
Reply to Office Action Dated May 6, 2005

Remarks

Claims 11-26 and 30-43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 6,283,375 to Wilz, Sr. ("Wilz") in view of U. S. Patent No. 5,668,803 to Tymes et al. ("Tymes"). Previously, claims 11-26 and 30-43 were rejected under 35 U.S.C. §103(a) over Wilz. However, the applicant has overcome the rejection under 35 U.S.C. §103(a) over Wilz:

Applicant's arguments, see pages 9-16, filed February 2, 2005, with respect to the rejection(s) of claim(s) 11-26 and 30-32 under 35 U.S.C. §103(a) over Wilz, Sr. have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. *Statement of Examiner, Examiner Office Action dated May 6, 2006.*

The applicant believes that all claims are allowable, with a minor amendment to change the dependency of claims 33 and 34. Briefly, independent claim 11 recites a portable device which among other elements includes an imaging assembly and a control circuit wherein the control circuit is configured to operate in a mode in which the control circuit sends to a spaced apart device an image along with a set of instructions instructing the spaced apart device to (a) decode a bar code symbol represented in said image to generate a decoded-out message and (b) transmit back to the portable device said decoded out message.

Independent claim 17 recites a method for operating a portable device including among other steps the step of storing into memory an image file having an open byte memory location and writing into the open byte memory location decoded-out message data.

Independent claim 22 recites a method for operating a portable device including among other steps the steps of storing into a memory an image file in an image file format, decoding a bar code represented in an image, converting decoded out message data into an image representation of decoded-out message data and stitching the image representation of the decoded-out message data into the image file.

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Independent claim 30 recites a method for operating a portable device including among other steps the steps of actuating an image capture function a first time to capture a first image representation corresponding to a first view of a package, actuating an image capture function of the device a second time to capture a second image representation corresponding to a second view of the package, and associating the image representations with a decoded out message produced by decoding of a decodable symbol affixed to the package.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991), cited in MPEP §2143.

The Examiner has not established *prima facie* case of obviousness as to any claim.

Regarding claim 11, the Examiner, as best understood, alleges that columns 15 and 21 of Tymes supplies the teaching of sending an image together with a set of instructions instructing the spaced apart device to (a) decode a bar code symbol represented in said image to generate a decoded-out message and (b) transmit back to the portable device said decoded out message. In a purportedly relevant section Tymes states:

The base station, 12, 13 or 14 receives the RF transmission packet 17 from the remote unit 15, decodes it on the fly, checks for errors, sends an RF acknowledge signal packet 18 to the remote unit 15 during the precise time window, and reformats the data in memory 31 by instructions executed by the CPU 30 for sending to the host computer 10 via communications line 11. (Tymes, column 15, lines 30-36)

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In order to establish a case of *prima facie* obviousness, the Examiner must demonstrate that a prior art reference or references when combined teach or suggest all claim limitations not just select claim limitations of a claim. Claim 11 specifically recites a control circuit which sends to a spaced apart device an image along with a set of instructions instructing the spaced apart device to (a) decode a bar code symbol represented in said image to generate a decoded-out message and (b) transmit back to the portable device said decoded-out message. The Examiner at least does not show, and does not even attempt to show that the combination of Wilz and Tymes teaches a control circuit that sends to a spaced apart device an image along with a set of instructions instructing the spaced apart device to (b) transmit back to the portable device said decoded-out message. With regard to the element of (b) transmit back to the portable device said decoded-out message (which according to the claim is a decoded out bar code symbol message) the Examiner merely alleges that Tymes teaches a base station that sends back a "response" (the Examiner quotes the line in Tymes that a base station "sends a response back to the base station via link 11, which the base station holds in memory 31 for sending to the remote unit 15"). However, the sending of a generic "response" to a base station does not satisfy the claim element of sending a decode out bar code message generated by decoding a bar code symbol represented in an image. The "response" of Tymes is further described as follows: "For example, the data sent from the host computer 10 may tell the user of the remote unit 15 to take some action with respect to the package which had the bar code symbol on it just read by the trigger pull, *i.e.*, place the package on a certain bin, etc." (Tymes, column 15, lines 50-54). The Examiner fails to allege that Tymes describes decoded out bar code message data being received by a portable device.

The Examiner also fails to consider all of the claim limitations of claim 17. For example, claim 17 recites among other steps the step of storing into memory an image file having an open byte memory location and writing into the open byte memory location decoded-out message data.

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In attempting to demonstrate that the combination of Wilz and Tymes teaches the elements of claim 17, the Examiner references the claim elements of claim 11. For example, in rejecting claim 17, the Examiner states that "Wilz, Sr. fails to teach or fairly suggest sending the image to a separately housed spaced apart device together with a set of executable instructions." However, the sending of "executable instructions" is an element of claim 11 not claim 17. The Examiner at least does not show and does not attempt to show that Wilz teaches the element of "writing the decoded-out message data...into the image file open byte memory location as is specifically recited in claim 17." At least because the Examiner has failed to even allege that Wilz teaches element (c) of claim 17, the Examiner has failed to establish a *prima facie* case of obviousness as to claim 17.

In attempting to demonstrate that the combination of Wilz and Tymes teaches the elements of claim 22, it appears that the Examiner again considers the elements of claim 11, not the claim elements that are actually recited in claim 22. In rejecting claim 22, the Examiner states that "Wilz, Sr. fails to teach or fairly suggest sending the image to a separately housed spaced apart device together with a set of executable instructions." However the sending of instructions is an element of claim 11, not of claim 22. Comparing the elements of actual original claim 22 to the Examiner's characterization of original claim 22, applicant respectfully asserts that the rejection of claim 22 has been based on claim elements other than what was actually recited in claim 22. Specifically, the Examiner does not consider or attempt to consider at least the (c) converting and (d) stitching steps of claim 22. The Examiner has failed to even allege that Wilz teaches or suggest all of the elements of claim 22 and, therefore, the Examiner has failed to establish a *prima facie* case of obviousness as to claim 22.

Regarding claim 30, claim 30 recites the combination of steps of actuating an image capture function a first time to capture a first image representation corresponding to a first view of a package, actuating an image capture function of the device a second time to capture a second image representation corresponding to a second view of the package, and

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associating the image representations with a decoded-out message produced by decoding of a decodable symbol affixed to the package.

While claim 30 recites the specific combination of steps of actuating an image capture function a first time to capture a first image representation corresponding to a first view of a package, actuating an image capture function of the device a second time to capture a second image representation corresponding to a second view of the package, and associating the image representations with a decoded out message produced by decoding of a decodable symbol affixed to the package, the Examiner does not show, and does not attempt to show that Wilz teaches the above combination of steps. In order to establish a case of *prima facie* obviousness the Examiner must demonstrate that the prior art teaches or suggests all of the elements of the claims not just some of the elements.

With the rejection of claim 30, as is the case with the rejection of claims 17 and 22, it appears that the Examiner considers the combinations of elements of claim 11, not the combination of elements actually recited in the respective claims 17, 22, and 30. A plurality of claims *should never* be grouped together in a common rejection, unless that rejection is equally applicable to all claims in that group." (Emphasis added) MPEP §707.07(d).

In view of the above, applicant believes that independent claims 11, 17, 22, and 30 are allowable. Dependent claims 12-16, 18-21, 23-26, and 31-32 are believed to be allowable for the reason that they depend on an allowable base claim and for the additional combinations of elements they recite.

While the applicant points to select combinations of elements not considered by the Examiner relative to claims 11, 17, 22, and 30 in order to demonstrate that a *prima facie* case of obviousness has not been established, the applicant reserves the right to point out further deficiencies with the Examiner's action in a future correspondence.

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Regarding the dependent claim rejections, applicant notes that there are numerous deficiencies with the rejections of the dependent claims. For example, regarding claims 12 and 13 reciting specific LED structures in combination with other elements, the Examiner does not even attempt to establish that Wilz teaches LEDs of an illumination assembly or that Wilz teaches or suggests white LEDs. Regarding claims 21 and 26 reciting wireless transmission features in combination with other elements, the Examiner does not attempt to establish that Wilz teaches wireless transmission in the combination claimed by the applicant. Regarding claim 15 reciting a portable device in a cellular phone form factor in combination with other elements, the Examiner points to a section of Wilz discussing a device (which does not appear to be the device cited in improperly rejecting the base claim) that is merely in communication with a cellular network. Regarding claim 18 reciting a .PDF image file format (*i.e.*, Portable Document Format, developed by ADOBE) in combination with other elements, the Examiner points to a section of Wilz discussing the PDF (Portable Data File) type bar code symbol. Regarding dependent claims 34 and 35, it is noted that the device 181 of Wilz (Fig. 8A) which the Examiner alleges is a "portable device" according to claim 11 is devoid of a display and a keyboard and that the Examiner discusses another system of Wilz, (the system of Fig. 6A) and not the system of Fig. 8A in rejecting claims 33 and 34. The Examiner does not even mention, much less consider, the specifically recited elements of several claims, such as claims 35, 36, 37, 39, 40, 41, and 42. The applicant's selective treatment of a subset of the dependent claims for purposes of generally demonstrating the inadequacy of the Examiner's rejections will not be taken as an admission that the applicant believes that the rejections of the claims not discussed are properly made.

In a telephone interview of May 31, 2005, the applicant's representative explained certain deficiencies with the Examiner's May 6, 2005 Office Action.

In summary, during a telephone interview on May 31, 2005, the applicant's representative pointed out significant deficiencies in the rejections presented by the Examiner for each respective independent claim. In response to the arguments presented, the Examiner did not attempt to substantively defend any outstanding rejection (except to the extent that the

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Examiner explained certain rejections were based upon what the Examiner termed as "stretched" construction of the prior art teachings and/or claims), and the Examiner did not attempt to explain any outstanding rejection with reference to any specific teachings of the prior art.

Accordingly, in view of the above amendments and remarks, applicant believes all of the claims of the present application to be in condition for allowance and respectfully request reconsideration and passage to allowance of the application.


If the Examiner believes that contact with applicant's attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call applicant's representative at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

Respectfully submitted,

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